

REMARKS

As a preliminary matter, Applicants thank the Examiner for making the references submitted in the Information Disclosure Statement on January 23, 2004 of record and returning the initialed Forms PTO-1449 to the undersigned attorney.

Reconsideration of the application in view of the above amendments and following remarks is respectfully requested.

As set forth above, the specification has been amended at page 8 in order that the term used to represent a group of substituents matches the definition of the group in the specification as originally filed. No new matter has been added.

Claims 1-59 were pending. Claims 19-59, having been withdrawn by the Examiner in view of the election under the Restriction Requirement, are cancelled without prejudice to pursue in the future in a related application. Claim 1 is amended to reflect the election under the Restriction Requirement and to enhance the clarity of the claimed subject matter. With the amendment of claim 1, the proviso is no longer needed and is deleted. Claims 9 and 18 are amended to replace the reference to Table 1 with the names of the compounds listed therein (excepting any that is no longer encompassed by claim 1 as amended). No new matter has been added by the amendments to the claims. In view of the amendment to claim 1 for consistency with the election under the Restriction Requirement, claims 2 and 11 are now redundant and accordingly are cancelled. Therefore, claims 1, 3-10 and 12-18 as amended herein are now pending in the subject application.

In the Office Action dated June 22, 2006, claims 1-18 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. There are three parts to this rejection. This rejection is respectfully traversed.

In the first part of the rejection, claim 1 (and therefore claims 2-18 which reference claim 1) is objected to based on the use of the term “acyl” (in the definitions of R³-R⁶). The term “acyl” is believed to be not sufficiently descriptive of the groups set forth in the definition provided in the specification at page 8. The definition provided in the specification reflects the intent of Applicants. Accordingly, the term “acyl” group has been replaced with “acyl containing group” to clarify the subject matter described in the specification as originally

filed. Therefore, the revised term is more reflective of the definition provided in the specification.

In the second part of the rejection, claims 9 and 18 are objected to due to reference to “compounds 1-192 of Table 1”. As set forth above, claims 9 and 18 have been amended to insert specific compounds from Table 1 of the specification. As noted above, compounds that are no longer encompassed by amended claim 1 have not been included in claims 9 and 18 as amended.

In the third part of the rejection, claims 9 and 18 are objected to on the grounds that for some of the compounds (e.g., compound 177 and compound 149) in Table 1 there is alleged to be insufficient antecedent basis in claim 1 on which claims 9 and 18 are dependent. Compound 177 contains a benzyloxy group (i.e., -O-CH₂-Phenyl) as the R¹ substituent and compound 149 contains a -O-(CH₂)₂-morpholino group as the R¹ substituent. In claim 1, the definition of R¹ includes “alkoxy”. The term “alkoxy” is defined at page 6, lines 17-22 of the specification. At page 6, lines 20-22, the specification recites: “The alkoxy group may be unsubstituted or substituted, for example with an alkyl, cycloalkyl, alkenyl, acyl, aryl or heterocycle group(s).” Thus, an alkoxy group may be substituted, for example, with an aryl group. The term “aryl” is defined at page 7, lines 1-6 of the specification. At page 7, lines 1-2, the specification recites in part that “Aryl” refers to “an unsaturated aromatic carbocyclic group of 6 to 14 carbon atoms having a single ring (e.g., phenyl)....” Therefore, the benzyloxy group of compound 177 is encompassed by “alkoxy” of R¹ of claim 1 which permits the alkoxy to be substituted with a phenyl. As recited above, an alkoxy group may be substituted with a heterocycle group. The term “heterocycle” is defined at page 7, lines 7-8 of the specification. At page 7, lines 7-8, the specification recites in part: “Examples of heterocycles include oxazole, piperidine, piperazine and morpholine.” Therefore, the -O-(CH₂)₂-morpholino group of compound 149 is encompassed by “alkoxy” of R¹ of claim 1 which permits the alkoxy to be substituted with morpholine.

It is believed that the rejection of claims 1-18 under 35 U.S.C. § 112, second paragraph, has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action, claims 1-3, 5, 7-12, 14 and 16-18 were rejected under 35 U.S.C. § 102(b) as lacking novelty over Hitchings et al. (U.S. Patent No. 2,691,655). This rejection is respectfully traversed.

As set forth above, amended claim 1 recites substituents for R^1 and R^2 that do not include H at either. All the compounds of Hitchings et al. have unsubstituted phenyl or naphthyl. The unsubstituted phenyl or naphthyl of Hitchings et al. is at a position that corresponds to the phenyl of Applicants' claim 1 that bears R^1 , R^2 and R^7 . Claim 1 does not provide for a naphthyl in place of the phenyl. As to the unsubstituted phenyl of Hitchings et al., this would require all of R^1 , R^2 and R^7 of claim 1 to be H. In contrast, as described herein, amended claim 1 does not recite H for R^1 and R^2 . Therefore, amended claim 1 (and therefore claims 2-18 which reference claim 1) does not read on the compounds of Hitchings et al. It is noted that claims 9 and 18 which have been amended to incorporate certain of the compounds of Table 1 do not include compounds in which either R^1 or R^2 , or both R^1 and R^2 , are H. For example, Compound No. 106 of Table 1 is not included in amended claims 9 and 18. Accordingly, Hitchings et al. cannot be considered to have taught the subject matter of amended pending claims 1, 3-10 and 12-18. As described above, claims 2 and 11 have been cancelled as redundant in view of the amendment of claim 1.

Therefore, it is believed, that this rejection of claims 1-3, 5, 7-12, 14 and 16-18 under 35 U.S.C. § 102(b) has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action, claims 1-3, 5-7, 10-12 and 14-16 were rejected under 35 U.S.C. § 102(b) as lacking novelty over Chaudhari et al. (PCT Application Publication No. WO 02/36586). This rejection is respectfully traversed.

As set forth above, amended claim 1 recites substituents for R^1 and R^2 that do not include H at either. The compounds of Chaudhari et al. that have a substituent other than H at the position corresponding to R^1 or R^2 do not have a substituent other than H at both R^1 and R^2 in the same compound. Thus, in these compounds of Chaudhari et al., there is H at R^1 or R^2 . In contrast, as described herein, amended claim 1 does not recite H for R^1 and R^2 . Therefore, amended claim 1 (and therefore claims 2-18 which reference claim 1) does not read on the

compounds of Chaudhari et al. It is noted that claims 9 and 18 which have been amended to incorporate certain of the compounds of Table 1 do not include compounds in which either R¹ or R², or both R¹ and R², are H. Accordingly, Chaudhari et al. cannot be considered to have taught the subject matter of amended pending claims 1, 3-10 and 12-18. As described above, claims 2 and 11 have been cancelled as redundant in view of the amendment of claim 1.

Therefore, it is believed that this rejection of claims 1-3, 5-7, 10-12 and 14-16 under 35 U.S.C. § 102(b) has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action, claims 1-3, 5-12 and 14-18 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hitchings et al. (U.S. Patent No. 2,691,655). This rejection is respectfully traversed.

The phenyl group in the compounds of Hitchings et al. is unsubstituted. Thus, the substituents at the positions on the phenyl group that correspond to R¹ and R² of claim 1 are both H. As set forth above, R¹ and R² of amended claim 1 do not recite H. Therefore, the compounds of amended claim 1 (and therefore claims 2-18 which reference claim 1) are not taught by Hitchings et al.

Furthermore, there is no teaching in Hitchings et al. to suggest that the compounds can possess a substituent other than H at both an ortho and a meta position of the phenyl group. There is no teaching in Hitchings et al. to suggest that the compounds of amended claims 1, 3-10 and 12-18 would have the activity desired by Hitchings et al. At best, the disclosure of Hitchings et al. would be an invitation to experiment to discover additional compounds having desired activity, with no reasonable expectation of success. It cannot be fairly said that Hitchings et al. contemplates the specific substitutions of the compounds of amended claims 1, 3-10 and 12-18. (Claims 2 and 11 have been cancelled in view of the amendment of claim 1.) Applicants respectfully submit that the Patent Office has failed to establish a *prima facie* case for obviousness.

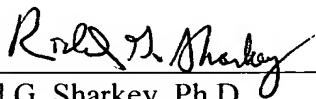
Therefore, it is believed that the rejection of claims 1-3, 5-12 and 14-18 under 35 U.S.C. § 103(a) has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

Therefore, in light of the amendments and remarks set forth above, Applicants believe that all the Examiner's rejections have been overcome. Reconsideration and allowance of the pending claims (1, 3-10 and 12-18) are respectfully requested. If there is any further matter requiring attention prior to allowance of the subject application, the Examiner is respectfully requested to contact the undersigned attorney (at 206-622-4900) to resolve the matter.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

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